

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

ROBERT E. BRIGGS and  
FRED M. TATUM

Serial No. 09/210,747

Filed: December 15, 1998



Group Art Unit: 1641

Examiner: V. Portner

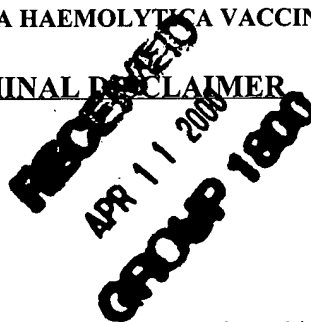
Atty. Dkt. No. 00295.77957

For: CONSTRUCTION OF PASTEURELLA HAEMOLYTICA VACCINES

TERMINAL DISCLAIMER

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:



The above-identified patent application has been assigned in its entirety to The United States of America as Represented by the Department of Agriculture and to Biotechnology Research and Development Corporation, whose address is 1815 North University Street, Peoria, Illinois 61604. This assignment was recorded at the United States Patent and Trademark Office on March 18, 1994, (in prior application serial no. 08/162,392) and is recorded on Reel No. 6995 at Frame Nos. 0086-0089.

I am a representative authorized to sign on behalf of the assignees. My name, title and address are set forth below. I have reviewed the aforementioned assignment document and certify that to the best of my knowledge and belief, title to the above-identified patent application is assigned to the United States of America and Biotechnology and Research and Development Corporation.

On behalf of the assignee, I hereby disclaim, except as provided below, the terminal part of the statutory term of any patent granted on the above-identified patent application, which would

04/19/2000 KDOWNING 00000006 190733 09210747

01 FC:148

110-00 CH

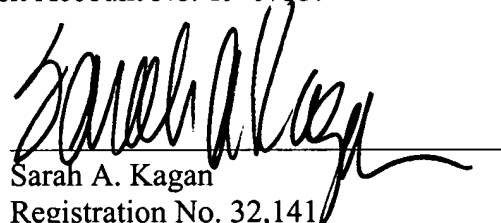
#  
18

extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of U.S. Patent Nos. 5,849,305 (the '305 patent) and 5,824,525 (the '525 patent), and hereby agree that any patent so granted on this patent application shall be enforceable only for and during such period that it and the '305 and '525 patents are commonly owned. This agreement is to run with any patent granted on this patent application and to be binding upon any grantee, its successors or assigns.

Assignee, however, does not disclaim any terminal part of any patent granted on this patent application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the '305 and '525 patents, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer.

Please charge the \$110.00 fee to our Deposit Account No. 19-0733. Also, please charge any deficiencies or credit any overpayment to our Deposit Account No. 19-0733.

Date: April 7, 2000

  
Sarah A. Kagan  
Registration No. 32,141  
Attorney of Record

BANNER & WITCOFF, LTD.  
1001 G Street, NW  
Eleventh Floor  
Washington, DC 20001-4597  
(202) 508-9100

**SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM**

DATE: 4-27-01

APPL. S.N.: 091 210, 247

TO EXAMINER: V. Portner

ART UNIT: 1645

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 4-27-00

AFTER FINAL YES ☒ NO ☐ NUMBER OF T.D(S). FILED 1

**INSTRUCTIONS:** I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: \_\_\_\_\_

☐ Suggestion to request refund of \$ \_\_\_\_\_. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

**FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:**

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)